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In re Application of :
LINDBO, Sverker :
U.S. Application No.: 09/445,845 :
PCT No.: PCT/US99/21248 :
Int. Filing Date: 22 September 1999 :
Priority Date: 24 September 1998 :
Attorney's Docket No.: 639321.0005 :
For: AN INTERNET CACHING SYSTEM :
AND A METHOD AND AN :
ARRANGEMENT IN SUCH A SYSTEM :

DECISION

The decision is in response to applicant's petition under 37 CFR 1.47(b) submitted on 08 September 2000 requesting that the United States Patent and Trademark Office accept a declaration without the signature of the sole inventor.

BACKGROUND

On 22 September 1999, applicant filed the above-captioned international application claiming priority to a Swedish patent application filed 24 September 1998. No Demand was filed electing the United States prior to the expiration of 19 months from the priority date. Accordingly, the twenty-month period for entering the national stage expired on 24 May 2000.

On 14 December 1999, applicant filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, an unexecuted declaration, a check in the amount of \$1,138.00 for the petition fee and additional claims, and authorization to charge Counsel's Deposit Account 11-0231 for any additional fees which may be required.

On 08 September 2000, applicant submitted the following papers: a "Combined Declaration Under 37 C.F.R. § 1.63 and Oath/Power of Attorney"; a "Statement Under 37 C.F.R. §373(b) Establishing Proprietary Interest by Person Signing on Behalf of Nonsigning Inventor"; a "Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor Pursuant to 37 CFR § 1.47" ("Chaclos Decl."); a copy of two pages of e-mail dated 05 May 2000; a copy of a letter dated 22 March 2000; and a copy of an assignment ("Assign.") dated 09 November 1999 for the above-identified invention.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Applicant failed to satisfy items (2) and (4).

Applicant has submitted the petition fee of \$130.00. Item (1) has been satisfied.

With regard to item (3), the 37 CFR 1.47(b) applicant states that the last known address of the sole inventor is 40 Elm Street, Wellesley, Massachusetts 02481. Item (3) has been satisfied.

Regarding item (5), section 409.03(f) of the MPEP states, in part:

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP Section 324).

In this case, applicant has submitted a copy of an assignment dated 09 November 1999 and a "Statement Under 37 C.F.R. §373(b) Establishing Proprietary Interest by Person Signing on Behalf of Nonsigning Inventor" executed by Mr. Aittola. The assignment is signed by the sole inventor, Sverker Lindbo, who assigned and transferred the entire right, title and interest in the invention titled an "Internet Caching System and a Method and an Arrangement in Such a System" for Swedish patent application number 9803246-9 to the 37 CFR 1.47(b) applicant, Mirror Image Internet, Inc, its successors, assigns, and legal representatives, the full and exclusive right to this invention and to any and all inventions described in the patent application for the United States, its territorial possessions and all foreign countries. This evidence is sufficient to prove that the 37 CFR 1.47(b) has sufficient proprietary interest in the above-captioned application to satisfy item (5).

Concerning item (6), section 409.03(g) of the MPEP states that "irreparable damage may be established by showing that a filing date is necessary to (A) avoid an imminent statutory bar (35 U.S.C. 102) or (B) make a claim for priority (35 U.S.C. 119, 120, and 121)."

Here, irreparable damage appears to be alleged via the claim that "[t]his statement also recites facts as to why this action was necessary to preserve the rights of the parties and to prevent irreparable damage." Chaclas Decl. ¶ 1. No such facts were expressed in Mr. Chaclas' statement. Further, a review of the e-mail submitted references "important deadlines that may be missed," but does not clarify what these deadlines are. Nevertheless, in paragraph two of the "Combined Declaration Under 37 C.F.R. § 1.63 and Oath/Power of Attorney," the 37 CFR 1.47(b) declares that "[m]y signing is necessary on behalf of Mr. Lindbo to prevent abandonment of the application and loss of rights associated therewith." This statement is sufficient to meet the requirements of Item (6).

However, regarding item (2), section 409.03(d) discusses the proof required to prove a refusal by an inventor and states, in part:

When it is concluded by the 37 CFR 1.47 applicant that a non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a non-signing inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In this case, applicant states that after sending a copy of the application to the inventor, "Mr. Lindbo expressly refused to sign in writing as evidenced by the attached letter from his lawyer Mark Shub dated March 22, 2000. Further, we requested Timo Aittola, who has a personal and professional relationship with Mr. Lindbo, additionally request signature *[sic]* by Mr. Lindbo. At such time, Mr. Lindbo corresponded with me directly via e-mail. The attached e-mail dated May 5, 2000, from Mr. Lindbo to myself, demonstrates his refusal to sign." Chaclas Decl. ¶ 5.

Petitioner has not provided adequate proof that the sole inventor refuses to sign the application. A copy of a letter from Mr. Lindbo's attorney, Mark Shub, to Cummings and Lockwood dated 22 March 2000 is attached. In the letter, counsel explains that Cummings and Lockwood "have supplied no information as to who you represent or why you are requesting that Mr. Lindbo execute these documents. Without further information regarding this matter, Mr. Lindbo will not sign any of these documents." This is not an express refusal. Moreover, applicant needs to explain why Mr. Shub claims that the inventor is unaware of the identity of the entity requesting his signature. Furthermore, Mr. Lindbo's states in the 05 May 2000 e-mail to Mr. Aittola that:

Until such matter is resolved, I will not sign any documents in favor of Mirror Image Internet, Inc. in relation to these patents.

Should there be instances where my signature is required to

prevent irrevocable loss of any intellectual property value, I propose that you have the patents transferred to an escrow agent, acceptable to both parties. **I will be willing to sign** all relevant documents in favor of such an escrow agent.
[Emphasis added.]

Clearly, this is not an express refusal to sign. In addition, section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) adds another requirement to proving a refusal and states, in part that:

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature.

In this case, applicant states that “[o]ur bona fide attempt at acquiring the inventor’s signature consisted of providing Mr. Lindbo, the inventor, with a copy of the application and associated Oath/Declaration.” Chaclas Decl. ¶ 4. In the e-mail dated 05 May 2000, Mr. Lindbo admits that he “receive[ed] two batches of patent documentation for my signature.” Nonetheless, these statements are not sufficient to prove that the inventor was presented a complete copy of all of the application papers as required. For the reasons discussed above, item (2) is not satisfied.

Moreover, concerning item (4), applicant has submitted a Combined Declaration and Power of Attorney signed by Timo Aittola, Chief Financial Officer of Mirror Image Internet Inc. who states that he is “an authorized representative of Mirror Image Internet, Inc.” Section 324 of the MPEP states that “[t]he submission may be signed by any person, if the submission includes an averment that the person is empowered to sign the submission on behalf of the assignee. Mr. Aittola’s declaration is sufficient to meet the requirement of section 324, however, the declaration itself fails to comply with 37 CFR 1.497 and 1.63. Specifically, it does not include the statements required under 37 CFR 1.497(a)(4) and 1.63(a)(4). In addition, the declaration does not list Mr. Aittola’s citizenship, residence, and post office address as required by 37 CFR 1.497(b). Thus, item (4) is also not satisfied.

Accordingly, since applicants failed to meet item(s) (2) and (4), it is not appropriate to accept this application under 37 CFR 1.47(a) at this time.


CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response

must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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